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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,433	07/26/2001	Rick Allen Hamilton II	AUS920010556US1	7376
35525	7590	03/20/2006	EXAMINER	
IBM CORP (YA)			TRAN, QUOC A	
C/O YEE & ASSOCIATES PC			ART UNIT	
P.O. BOX 802333			PAPER NUMBER	
DALLAS, TX 75380			2176	

DATE MAILED: 03/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/915,433

Applicant(s)

HAMILTON ET AL.

Examiner

Quoc A. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-7, 9-12, 14-19 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-12 is/are allowed.
- 6) ☒ Claim(s) 2-7, 9-10, 14-19 and 21-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to Amendment filed 01/10/2006, with acknowledgement of original filing date of 07/26/2001.
2. Claims 2-7, 9-12, 14-19 and 21-24 are pending. Applicant has amended claims 2-7, 9-12, 14-19, 21-24 and has cancelled claims 1, 8, 13 and 20. Claims 5, 10-12, 17 and 22-24 are independent claims.

Allowable Subject Matter

3. Claims 11-12 allowed.
4. Claims 2-7, 9-10, 14-19 and 21-24 would be allowable if rewritten to overcome the rejection under 35 U.S.C. 101 set forth below (see the current rejection for details).

Response to Argument

5. Applicant's arguments, see Remarks, filed 01/10/2006, with respect to the rejection(s) of claim(s) 2-7, 9-12, 14-19 and 21-24 under 35 U.S.C. 103(a) as being unpatentable over Kim et al. US 20020129014A1 – filed 01/10/2001, in view of Law et al. US Patent No. 6,754,873 B1 - filed 04/06/2000, have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made set forth below.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claims 2-6, 7, 9, 17-19 and 21-24, and 31-43** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 2-6, 7, 9, 17-19 and 22, set forth functional descriptive material but fail to produce a "useful, and tangible" result; **Claims 2-6, 7, 9, 17-19 and 22**, are interpreted as software per se, abstracts ideas or mental construct and not tangibly embodied on a computer readable medium or hardware (see In The Claims pages 2-7);

(1) "USEFUL RESULT", For an invention to be "useful" it must satisfy the utility requirement of section 101 see MPEP § 2107 and Fisher, 421 F.3d at ___, 76 USPQ2d at 1230 (citing the Utility Guidelines with approval for interpretation of "specific" and "substantial"), and

(2) "TANGIBLE RESULT", For an invention to be "useful" it must satisfy the utility requirement of section 101 see MPEP § 2107 and see Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had "no substantial practical application."). "[A]n application of a law of nature or mathematical formula to a ... process may well be deserving of patent protection." Diehr, 450 U.S. at 187, 209 USPQ at 8 (emphasis added); see also Corning, 56 U.S. (15 How.) at 268, 14 L.Ed. 683 ("It is for the discovery or invention of some practical method or means of producing a beneficial result or effect, that a patent is granted . . .");

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Claims 2-6, 7, 9, 17-19 and 22, are interpreted as software per se, abstracts ideas or mental construct and not tangibly embodied on a computer readable medium or hardware.

Claims 23-24 set forth functional descriptive material but fail to produce a "useful" result (see In The Claims pages 8-10);

(1) "USEFUL RESULT", For an invention to be "useful" it must satisfy the utility requirement of section 101 see MPEP § 2107 and 2107 and Fisher, 421 F.3d at ___, 76 USPQ2d at 1230 (citing the Utility Guidelines with approval for interpretation of "specific" and "substantial").

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quoc A. Tran whose telephone number is (571) 272-4103. The examiner can normally be reached on Monday through Friday from 9 AM to 5 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Herndon R. Heather can be reached on (571) -272-4136. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Quoc A. Tran
Patent Examiner
Technology Center 2176
March 9, 2006

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
3/15/2006